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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1941

*Verdict*  
No. 968

*315-873*

MASSACHUSETTS HAIR & FELT CO.,  
Petitioner,

v.  
B. F. STURTEVANT Company,  
Respondent

## PETITION FOR WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

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v.

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Respondent

— — —  
**PETITION FOR WRIT OF CERTIORARI  
to the United States Circuit Court of Appeals  
for the First Circuit**

— — —  
*To the Honorable the Chief Justice of the United States,  
and the Associate Justices of the Supreme Court of  
the United States:*

Your petitioner, Massachusetts Hair & Felt Co., respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the First Circuit to reverse the judgment of that Court entered on September 29, 1941, rehearing denied November 21, 1941, and amended on a second rehearing December 15, 1941.

### SUMMARY AND SHORT STATEMENT

The issues here relate to extension of monopoly.

Petitioner was defendant in the District Court where the case was referred to a master. The master reported claim 1 of the first Hagen patent, 1,846,863, invalid, and claim 2 valid and infringed, and reported the second Hagen patent, 1,989,413, invalid. This report was confirmed by the District Court.

The Circuit Court of Appeals for the First Circuit affirmed the District Court with respect to the first Hagen patent and reversed it with respect to second Hagen patent, holding claim 1 of the first patent invalid and claim 2 valid and infringed, and holding all claims of the second patent valid and infringed.

The primary issue with respect to the first patent is the extension of monopoly by the respondent in re-patenting an admittedly old basic combination, although the only claim to invention lies in the design of one element thereof. The primary issue with respect to the second patent is the extension of the monopoly of the first patent by re-patenting the invention thereof with unpatentable additions.

Both patents in suit relate to the use of adjustable vanes located at the inlet of a conventional centrifugal fan or blower to control the spin of entering air and thereby control the output of the fan. They both utilize the ancient principle of reducing output of such a fan or blower by creating, in the entering air, a spin in the direction of rotation of the rotor or impeller of the fan.

In the first patent, a series of adjustable curved vanes 26 are used to control the output of a conventional centrifugal fan which is driven in the usual way by a con-

ventional constant speed motor. These vanes are arranged around the inlet of the fan. As the vanes are moved toward closed position, the spin in the entering air is increased and the output is reduced accordingly. When the vanes are nearly closed they cause substantially all of the air to spin and produce a condition known as tangential admission (R. V. II, p. 579).

The invention patented in Claim 2 of this patent is the old combination of a constant speed motor, a centrifugal fan, having a rotor and an inlet, and a plurality of vanes in the inlet forming fluid directing passages to admit fluid to the rotor with a spin in the direction of rotation of the rotor. The vanes are the improved element. They are defined in detail as adjustable to vary output from maximum capacity to minimum capacity with substantially tangential admission of fluid and as having adjacent surfaces continuously approaching parallelism and having extended overlapping portions shaped to define passages of substantially uniform cross section as the vanes are moved toward closed position (R. V. II, p. 581).

The Master found as a fact that there is no novelty in the first portion of Claim 2 through the provision for vanes which are adjustable to vary output and that the advance of Claim 2 therefore resides in the design and arrangement of the vanes (R. V. II, pp. 110-111). He could not find otherwise because the prior patents clearly showed the old combination.

In Eickhoff 928,034 (R. V. II, p. 670) the vanes *k* control the spin of air entering a fan or blower from maximum capacity to minimum capacity with substantially tangential admission of fluid. In Moody 1,460,428 (R. V. II, p. 678) vanes 25 in Fig. 1 and 32 in Fig. 2 control spin to control output. In Beaudrey French patent 589,469

(R. V. II, p. 765) vanes 3 control output at constant speed from maximum to minimum by controlling spin. In Brown, Boveri Swiss patent 99,575 (R. V. II, p. 747) vanes 1 control spin and thereby control fan output.

The differences claimed by the respondent over these prior art patents which show the old combination are merely specific details of vane design or arrangement. The vanes *k* of Eickhoff are distinguished because they are flat instead of curved. Respondent points out that because of this the angle between their adjacent surfaces remains constant at all positions and the vanes never approach parallelism and do not define passages of substantially uniform cross section as they are moved toward closed position. The respondent contends that the Moody patent does not disclose with sufficient detail the exact shape of the vanes and that they might be stream lined, in which case they might not give tangential admission at minimum capacity, and might not approach parallelism or define passages of substantially uniform cross section. Respondent urges further that Moody does not disclose the full range of adjustment from maximum to minimum capacity. The respondent urges that Beaudrey does not anticipate because the vanes are streamlined in cross section instead of merely curved as in the first Hagen patent and that consequently there is no tangential admission at minimum capacity and the vane surfaces do not approach parallelism or define passages of uniform cross section. The respondent urges that the Brown, Boveri vanes are not disclosed with sufficient clarity and that their range of movement is not clearly defined as being from maximum to minimum and that it is not clear that the fan is operated at constant speed.

The inventive concept claimed by respondent for the first Hagen patent is the wide range of control from

maximum to minimum with tangential admission at the minimum and the more predictable, better control, said to be peculiar to vanes of the claimed design which give spin control throughout this range.

The second Hagen patent extends the monopoly of the first one by adding to it features old in the art. The basic inventive concept of the claims of this patent is the adjustment from maximum to minimum capacity, with tangential admission at the minimum, of vanes which throughout this adjustment direct the entering air to the fan rotor with an appreciable spin. These vanes are defined as being pivoted in a conical inlet on axes oblique to the rotor axis and perpendicular to the conical inlet (R. V. II, p. 588).

This particular mounting of the vanes 16 in the conical inlet 12 is shown in Fig. 2 of the patent (R. V. II, p. 586). It is identical with the optional, conical mounting of the vanes 32 described by Moody in his specification (R. V. II, p. 280, line 63 *et seq.*) which is illustrated in Exhibit MMMM (R. V. II, p. 784). There the vanes 32 are pivoted on axes oblique to the rotor axis and perpendicular to the conical inlet.

### **The Master's Report**

The master made extensive findings in holding Claim 1 of the first Hagen patent invalid and Claim 2 valid and infringed and in holding the second patent invalid.

The master found that Hagen does not claim to have discovered the principle of spin control and that he does not claim to have invented broadly an apparatus for producing and varying spin of air entering a fan by an arrangement of adjustable vanes at the inlet (R. V. I, p. 55).

He found that Eickhoff 928,034 (R. V. II, p. 670) shows and describes vanes surrounding the inlet of a fan and adjustable to increase or decrease spin component of entering air from maximum to minimum as means for controlling output (R. V. I, p. 81) and that Eickhoff provides substantially tangential admission (R. V. I, p. 83). He found, however, that in Eickhoff the straight vanes *k* do not continuously approach parallelism or define passages of substantially uniform cross section as they are moved toward closed position (R. V. I, p. 85).

He found that Moody 1,460,428 (R. V. II, p. 678) shows vanes to control spin of the entering fluid (R. V. I, p. 87). He found, however, that it is entirely consistent with Moody's specification that the vanes be streamlined and that such vanes would not continuously approach parallelism or define passages of uniform cross section and that they would not provide tangential admission at closing (R. V. I, pp. 89-90). He found also that Moody does not clearly disclose the full range of movement claimed by Hagen (R. V. I, p. 91).

He found that Beaudrey French patent 589,469 (R. V. II, p. 765) discloses the use of vanes to impart spin at constant speed to vary output from maximum to minimum (R. V. I, p. 93). He found, however, that the vanes were streamlined and would therefore not approach parallelism or form passages of uniform cross section and that they would not give tangential admission at closing (R. V. I, p. 95). He said that the vanes of Fig. 13 of Brown, Boveri Swiss patent 99,575 (R. V. II, p. 745) were substantially identical with Hagen's vanes (R. V. I, pp. 73-4), but found that the disclosure was not adequate, that it did not clearly disclose constant speed operation or the full range of adjustment of Hagen (R. V. I, pp. 77-8).

He found that there is no novelty in the first portion of Claim 2 through the provision for vanes adjustable to vary output and found that the advance of Claim 2 resides in the design and arrangement of vanes (R. V. I, pp. 110-11).

The master found that the second Hagen patent is invalid for lack of invention. He found that Moody 1,460,428 shows the elements of the first part of the claims, namely the rotor, the casing, the conical inlet and the vanes pivoted on oblique axes, but that Moody does not show the wide range of adjustment which is common to both Hagen patents and therefore does not anticipate (R. V. I, p. 117). He found, however, that there could not be any invention in view of Hagen's first patent in arranging the vanes in the eye of a forced draft fan and making them adjustable from a wide open position through 90° to a closed position for the purpose set forth in the claims and that there could be no invention in using the old conical inlet and the oblique axes, in particular, because this particular manner of mounting vanes is described in Moody (R. V. I, p. 118).

#### **The Decision of the District Court**

The District Court confirmed the master's report. The District Court held that Eickhoff showed vanes adjustable to increase or decrease spin from maximum to minimum as means for controlling output and described the use of such vanes and that Beaudrey discloses out to control output at constant speed by supplying spin and adjusting it (R. V. I, pp. 165-6).

The District Court agreed with the master and the structures and method of mounting the vanes of the second Hagen patent does not constitute invention and that Moody discloses this type of structure and method of mounting (R. V. I, p. 168).



### The Decision of the Court of Appeals

The Circuit Court of Appeals wrote two opinions and amended the second opinion. In its first opinion with reference to the first Hagen patent, it found that Hagen makes no claim to have discovered the principle of spin control or to have invented broadly the apparatus for producing and varying spin with adjustable vanes in the inlet of a fan (R. V. III, p. 799). It found that it involved invention to use Hagen's curved vanes and to adjust them through the wide range from maximum to minimum (R. V. III, p. 812). It agreed with the master's findings with reference to the prior art, reviewing them specifically. It found that the important difference between Eickhoff and the first Hagen patent is that Eickhoff uses flat vanes instead of curved ones and that flat vanes can never approach parallelism and define passages of uniform cross sectional area when moved toward closed position (R. V. III, p. 811). It found that Moody differed in the form of vane since Moody did not have vanes which would approach parallelism or define the passages of uniform cross sectional area or provide substantially tangential admission on closing. It made the same finding with reference to Beaudrey and Brown, Boveri (R. V. III, pp. 810-811).

It approved the master's finding that the advance of Claim 2 resides in the design and arrangement of the vanes.

In a petition for rehearing, petitioner pointed out that the findings that Hagen was not the inventor of the first portion of Claim 2 and that his invention resides in the design and arrangement of the vanes as specified in the last portion of Claim 2 made the decision of this court in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, applicable because in Claim 2 of the first patent Hagen claimed the old combination of the constant speed motor, the fan and vanes (R. V. III, pp. 821-2).

The Court of Appeals re-considered the matter in the light of this case and of *Bassick Mfg. Co. v. Hollingshead*, 298 U. S. 415. It held that Hagen's first patent does not claim an old combination with a new element, but only claims a new element and that these cases are therefore not in point. The court reviewed the admissions of the plaintiff and the findings of the master that the combination is old and concluded that Claim 2 was valid (R. V. III, p. 824).

Both parties then requested a reconsideration (R. V. III, p. 827). The Circuit Court of Appeals then amended the opinion by striking out the three paragraphs in which it made the above discussed findings and which appear at the top of page 824 of Vol. III and substituted a new paragraph (R. V. III, p. 828). In this new paragraph the court reverses itself, stating that Hagen's claim covers a combination. It states that the *Lincoln* and *Bassick* cases are not in point because the respondent did not attempt to prevent others from using any form of vane controlled centrifugal fan, but attempted only to prevent others from using such a fan with inlet vanes substantially similar to his.

The court said that the new form of vane caused the combination to produce a new useful result which is not the aggregate of the several results.

The Court of Appeals does not specify what new result it has in mind, but it is apparent that the court had in mind what it terms the more predictable better results attendant upon using the vanes of the first Hagen patent.

With reference to the second Hagen patent, the Court of Appeals found that the invention of the second Hagen patent was in combining the parts to give the more predictable better control over a wide range which is claimed for both Hagen patents (R. V. III, p. 815). It held that

the master and the District Court erred in holding the second patent invalid. It held that it was not necessary for the second Hagen patent to embody a patentable advance over the first Hagen patent because the applications for the Hagen patents were co-pending (R. V. III, p. 816).

### REASONS RELIED UPON FOR THE ALLOWANCE OF THE WRIT

Petitioner believes that a writ of certiorari should be granted in this case for the following reasons and accordingly the discretionary power of this Court is invoked:

1. The Circuit Court of Appeals for the First Circuit, in holding Claim 2 of Hagen patent 1,846,863 valid over the prior art, has rendered a decision in conflict with the decisions of this Court in *Bassick v. Hollingshead*, 298 U. S. 415, and *Lincoln v. Stewart-Warner*, 303 U. S. 545, which prohibit the extension of the monopoly of an expired patent by merely substituting an improved element for the same element in an old combination.

2. The Circuit Court of Appeals for the First Circuit, in holding Hagen patent 1,989,413 valid over the prior art, has rendered a decision in conflict with the decisions of this Court in *Bassick v. Hollingshead*, 298 U. S. 415, and *Lincoln v. Stewart-Warner*, 303 U. S. 545, which prohibit the extension of monopoly by adding mechanical details old in the art to an old combination.

3. The Circuit Court of Appeals for the First Circuit, in holding that the decisions of this Court in *Bassick v. Hollingshead*, 298 U. S. 415, and *Lincoln v. Stewart-Warner*, 303 U. S. 545, are applicable only to cases in which a patentee who has re-patented an old combination with an improved element and is trying to prevent others from selling or using old elements of the combination, has ren-

dered a decision in conflict with those decisions or has raised a point of law which has not been and should be settled by this Court.

4. The Circuit Court of Appeals for the First Circuit, in holding that Hagen patent 1,989,413 is valid over Hagen patent 1,846,863 and the prior art on the ground that it is not necessary for the second Hagen patent 1,989,413 to involve a patentable advance over Hagen patent 1,846,863, because the applications were co-pending, has decided an important question of Federal Law which has not been but should be settled by this Court, and has decided it in a way contrary to an important body of decisions of far-reaching scope.

#### PRAYER

Wherefore, your Petitioner respectfully prays that a Writ of Certiorari be issued to the Circuit Court of Appeals for the First Circuit to the end that this cause may be reviewed and determined by this Court in accordance with principles of law heretofore announced by it and that the judgment of the Circuit Court of Appeals for the First Circuit be reversed as to the findings of validity of Claim 2 of Hagen patent 1,846,863 and of all claims of Hagen patent 1,989,413, and that Petitioner be granted such other and further relief as may be proper.

MASSACHUSETTS HAIR & FELT  
COMPANY

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## BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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### THE OPINIONS OF THE COURTS BELOW

The master's report is found on pages 34-136 of Vol. I of the record. The opinion of the District Court is reported in 31 F. S. 975, and will be found at pages 164-8 of Vol. I of the record. The original opinion of the Circuit Court of Appeals is reported 122 F. (2d) 900. It will be found on pages 793-820 of Vol. III of the record. The

opinion of the Circuit Court of Appeals on rehearing and as amended thereafter is reported 124 F. (2d) 95, and will be found without amendment on pages 822-6 of Vol. III of the record, and the amendment thereto will be found on page 828 of Vol. III of the record.

### JURISDICTION

The decree of the Circuit Court of Appeals was entered September 29, 1941 (R. V. III, p. 821) and the original opinion was filed the same day (R. V. III, p. 793). The petition for rehearing was denied November 21, 1941 (R. V. III, p. 826) and the opinion on rehearing was filed the same day (R. V. III, p. 822). This opinion was amended on motion for rehearing December 15, 1941 (R. V. III, p. 827). The statute giving jurisdiction is 240-A of the Judicial Code (28 U. S. Code § 347). The judgment was rendered in a suit in equity under the patent statute to determine validity of Letters Patent of inventions.

The cases believed to sustain jurisdiction are:

*Lincoln Engineering Co. v. Stewart-Warner Corp.*,  
303 U. S. 545.

*Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477.

*Cities Service v. Dunlap*, 308 U. S. 208.

### STATEMENT OF THE CASE

The foregoing petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ and a statement of the questions involved in the case.



## **SPECIFICATION OF ERRORS**

The specification of errors relied upon are those reasons set forth in the petition for the writ as grounds for its allowance.

## **THE ISSUES**

The issues relate to extension of monopoly.

The first issue is whether an inventor, who has improved one element of an old combination, has any valid enforceable right in a patent in which he claims the old combination with the improved element substituted for the old element of the old combination.

The second issue is whether a patentee who has patented an invention may later obtain a second patent for the invention of the first patent with unpatentable additions, merely because the application for the second patent was co-pending with the application for the first patent.

## **SUMMARY OF ARGUMENT**

*Point 1.* The decision of the Circuit Court of Appeals for the First Circuit is in conflict with decisions of this Court which prohibit the extension of monopoly in that the Court sustained combination claims, although it found that the invention lay in improving one element only of the combination which was old.

*Point 2.* The Circuit Court of Appeals for the First Circuit has held that an inventor who has improved one element of an old combination and has patented the old combination with the improved element has a valid enforceable right under certain circumstances. This holding is untenable.

*Point 3.* The Circuit Court of Appeals for the First Circuit has held that an inventor who has obtained a patent for his invention may obtain a second and later patent, relying upon the same inventive concept by merely making unpatentable additions to the invention of his first patent, merely because the applications for the patents were co-pending. This holding is untenable.

## ARGUMENT

**POINT 1:** The decision of the Circuit Court of Appeals for the First Circuit is in conflict with decisions of this Court which prohibit the extension of monopoly in that the Court sustained combination claims, although it found that the invention lay in improving one element only of the combination which was old.

There is an impressive array of findings in this case that Hagen did not invent the combination of a centrifugal fan, a constant speed motor and vanes in the inlet to control spin and vary output. The following findings of the master, which culminated in the finding

“The advance of Claim 2, therefore, resides in the design and arrangement of vanes” (R. V. I, p. 111)

which was quoted with approval by the Court of Appeals (R. V. III, p. 811) are very clear and unequivocal.

“Hagen does not claim to have discovered the principle of spin control of a fan impeller. Nor does he claim to have invented broadly the method of or an apparatus for producing and varying the spin component of the entering air of a fan by an arrangement of adjustable vanes at the eye or inlet” (R. V. I, p. 55).

“In my judgment, Eickhoff shows and describes vanes surrounding a pump or fan inlet, which vanes are adjustable to increase or decrease the spin component of the fluid from maximum to minimum as means for controlling output, and that he describes the use of such vane adjustment for this purpose” (R. V. I, p. 81).

“Hagen does not claim to have discovered or developed the principle of control of fan output

at constant speed by the use of vanes at the inlet, adjustable to supply and control spin component" (R. V. I, p. 105).

"There is no novelty in the first portion of claim 2, through the provision for vanes which are adjustable to vary the output. A constant speed rotor with an inlet and a plurality of vanes therein, forming passages to admit fluid to the rotor with a spin component, the vanes being adjustable to vary the output, was old, and I do not understand that plaintiff contends otherwise. If there is patentable novelty in claim 2, it resides in the provision for vanes adjustable through the range from maximum to minimum capacity with a substantially tangential admission, the vanes having adjacent surfaces continuously approaching parallelism, etc., as specified in the last half of the claim" (R. V. I, p. 110-1).

The only distinction which the Courts below could find to distinguish the prior art were distinctions in vane design or arrangement with reference to the extent of adjustability. Eickhoff was distinguished because the vanes were flat instead of curved. Moody was distinguished because the vanes might be streamlined and might not be arranged for the wide range of adjustability. Beaudrey was distinguished because the vanes were streamlined. Brown, Boveri was distinguished because the vanes did not have the range of movement and were not shown in great detail.

The most that could be said for Hagen was that he had created an improvement in vanes so that they would give more efficient, definite, predictable and better control than the vanes that had been used before in the same combination. It is no wonder that the Court of Appeals found in its first opinion that Hagen's contribution was a mechanism for controlling the output of a centrifugal fan by vanes (R. V. II, p. 812) and later, on rehearing stated, in the

portion of the opinion which was stricken on second rehearing (R. V. III, p. 824):

“The plaintiff in the case at bar admits that ‘Centrifugal fans are very old, and adjustable inlet vanes are not new’. In view of this admission, which is in accordance with the testimony in the record, and of the master’s finding that there is no novelty in the first portion of this claim since ‘A constant speed rotor with an inlet and a plurality of vanes therein, forming passages to admit fluid to the rotor with a spin component, the vanes being adjustable to vary the output, was old, and I do not understand that plaintiff contends otherwise,’ we are of the view that the claim under consideration should not be construed as a combination claim but as an improvement one only. That is, that it should be construed as a claim only for vanes of a particular form arranged in the inlet in a particular way to produce a result’ asserted to be new and useful, not as a claim for those vanes plus a constant speed centrifugal fan with vanes in its inlet.”

All that Hagen did was add his particular vanes with their particular arrangement with respect to adjustability to the old combination on which the patents had expired. The only new result he could claim was a more efficient, definite, predictable and better control than the prior art vanes gave. The motor drove the fan just as it always had. The fan moved the air through the casing, just as it always had. The vanes controlled spin broadly, just as they always had to control output, but they were more efficient vanes when they embodied Hagen’s design.

A patentee cannot by improving one element of an old combination, whose construction and operation is otherwise unchanged, extend the monopoly on the combination and patent it again with the improved element in place of the old one.

In *Bassick Mfg. Co. v. Hollingshead Co.*, 298 U. S. 415, this Court said:

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler, and a grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such (No. 1,307,733). Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler (No. 1,307,734, the patent in suit; claims 1-6, 8 and 10). He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art (Claims 14 and 15). The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation are otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts" (p. 424).

In *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, this Court said:

"The invention, if any, which Butler made was an improvement in what he styles in his specifications the 'chuck' and in his claim a 'coupling member'. It is not denied that multi-jawed chucks had been used in industry and as couplers in lubricating apparatus. Butler may have devised a patentable improvement in such a chuck in the respect that the multiple jaws in his device are closed over the nipple by the pressure of the grease, but we think

he did no more than this. As we said of Gullborg in the Rogers Case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in his claimed combination. The patent is therefore void as claiming more than the applicant invented" (p. 549).

"The function of a pump has always been to force a fluid or a grease through a conduit. The fact that this function of the pump is utilized in Butler's improved form of coupler not only to convey the lubricant to the bearing but to operate the jaws of the chuck does not alter the function of the pump. The invention, if any, lies in the improvement in the coupling device alone" (p. 551).

Petitioner's position is that these cases are clearly in point. In both of them, the invention, if any, resides in improving one element of the old combination, a situation which the record and findings clearly establish in the present case. In both of them the claims were in the same form as Claim 2 of the first Hagen patent, where the claim starts out "The combination with".

The Court of Appeals had no trouble in seeing that the record clearly establishes that Hagen's invention, if any, was in the design of the vanes and it so found. When the matter came up on rehearing, the Court still saw that the record establishes that Hagen's invention was merely an improvement in vanes and the Court so found, but sought to avoid the effect of the *Bassick* and *Lincoln* cases by construing the claims as covering merely improvements in vanes (R. V. III, p. 824).

When it was called to the Court's attention on the second rehearing that the *Lincoln* and *Bassick* cases could not be so easily avoided, the Court construed the *Lincoln* and *Bassick* cases as applying only if a patentee sought to



prevent others from using any form of vane control and held that since the patentee was merely attempting to keep petitioner from using the specific form of vanes with a fan, the question thus presented is whether or not the new element caused the combination to produce a new and useful result, not merely the aggregate of several results.

It is difficult to follow this line of reasoning. The fact remains that the Court did not dispose of the clearly established fact that the combination was old and that Hagen had merely improved the vanes. The mere fact that the improved vanes made the old combination better did not make the old combination with the improved element patentable as a combination. In every case where an element is improved, the combination works better. Otherwise one could not say the element was improved. In the present case, the function of the motor remains unchanged. The function of the fan remains unchanged. Any improvement in the result flows from the improvement in vanes and not from any new coacting relationship.

The Court of Appeals and the District Court and the Master have all found that the combination was old and that the invention resides in the design of the vanes. Claim 2 of the patent claims the old combination with the vanes of new design in place of the old vanes. Under the *Bassick* and *Lincoln* decisions, such claims extend the monopoly and are invalid.

In the present case, the respondent was licensed under the Moody patent and was manufacturing under the license. It brought suit against petitioner on the Moody patent but dropped the suit, apparently because it preferred to have the extended monopoly of the Hagen patents which cover the same combination as Moody with the addition of the improvement in vanes (R. V. I, p. 409).

The above comments have been directed specifically to Claim 2 of the first Hagen patent, but they apply with equal force to the second Hagen patent, the claims of which are not directed merely to improved vanes, but are directed to a combination consisting of the fan, its rotor, its casing, the conical inlet passage and the vanes (R. V. II, p. 588). The Court of Appeals should have applied the rule of the *Lincoln* and *Bassick* cases to the second as well as the first Hagen patent.

The present case is a flagrant one of extension of monopoly. The failure of the Court of Appeals to follow the rule against extension of monopoly was erroneous. This constitutes grounds for certiorari.

*Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545

*Cities Service v. Dunlap*, 308 U. S. 208

**POINT 2:** The Circuit Court of Appeals for the First Circuit has held that an inventor who has improved one element of an old combination and has patented the old combination with the improved element has a valid enforceable right under certain circumstances. This holding is untenable.

When the Court of Appeals finally amended its opinion in the second rehearing, it construed the *Lincoln* and *Bassick* cases as holding that an inventor, who has improved one element of an old combination and who has claimed the old combination with the improved element, may enforce his patent against one who uses the old combination with the improved element. The Court stated that the *Lincoln* and *Bassick* cases do not apply except when the inventor seeks to keep others from using the old combination in every form (R. V. III, p. 828).

It is believed that this is a misinterpretation of these cases. It is true that in each of these cases the patentee was seeking to hold a contributory infringer who was supplying elements of the combination, knowing they were to be used in infringement of the patent.

It may be that it was the intention of this Court to hold that the rule of the *Lincoln* and *Bassick* cases applies only to such situations. If that is the case, this Court should clarify its holding.

We believe that the Court of Appeals has misconstrued the cases and that this Court intended them to apply to a situation in which the patentee has, by his claims, extended the monopoly on the old combination. We believe that this Court intended to have the cases apply to every such patent, regardless of what the patentee attempts.

If the situation created by the Court of Appeals decision is not corrected, other courts may conclude that the ruling of the *Bassick* and *Lincoln* cases is merely a limited one. Other courts may take the view that a patentee may extend the monopoly on an old combination if he is careful to enforce his patent only against direct rather than contributory infringers.

We submit that under the circumstances, this Court should grant certiorari either to clarify its ruling in the *Bassick* and *Lincoln* cases or to correct the action of the Court of Appeals in failing to follow the rulings.

**POINT 3:** The Circuit Court of Appeals for the First Circuit has held that an inventor who has obtained a patent for his invention may obtain a second and later patent, relying upon the same inventive concept by merely making unpatentable additions to the invention of his first patent, merely because the applications for the patents were co-pending. This holding is untenable.

The District Court and the Master held the second Hagen patent invalid. They saw that the respondent was merely seeking an extension of the monopoly of the first patent and they refused to permit this.

The District Court and the Master held that the claims of the second Hagen patent define no invention over Hagen's first patent in view of the prior art, in particular the Moody patent.

The Moody patent discloses the conical inlet and the vanes pivoted on axes oblique to the rotor axis and at right angles to the inlet defined by the claims of the second Hagen patent. The respondent contended, however, that Moody did not disclose the wide range of adjustment from maximum to minimum, or vanes which would direct the entering gas to the rotor with a spin throughout their adjustment. In other words, respondent contended that Moody was not an anticipation because it did not have the inventive concept on which the first patent was based, namely the wide range of control and the vanes designed to efficiently control spin.

The District Court and the Master saw that the respondent was seeking two patents based upon the same inventive concept, the first one covering broadly all vanes such as those shown in both Hagen patents, and the second one, through unpatentable additions taken from

Moody, covering the same invention in a more limited field.

The District Court did not question the finding that there was no invention over Hagen's first patent in view of the prior art. It is obvious that this conclusion is correct. The Court of Appeals, however, took the view that this was not enough to invalidate the second Hagen patent because its application was co-pending with the application for the first Hagen patent.

There is a large body of authority sustaining the position taken by the District Court and the Master.

*In re Byck*, 48 F. (2d) 665

*In re Robinson*, 48 F. (2d) 931

*In re Peiler*, 56 F. (2d) 878

*In re Mason*, 62 F. (2d) 185

*In re Gollmar*, 67 F. (2d) 907

*In re Neuberth*, 82 F. (2d) 718

*Bissell Carpet Sweeper Co. v. Coe*, 82 F. (2d)

821

*In re James*, 83 F. (2d) 313

*Oates v. Camp*, 83 F. (2d) 111

*In re Seebach* 88 F. (2d) 722

*In re Barge*, 96 F. (2d) 314

*In re Bertsch*, 107 F. (2d) 828

*In re Land*, 109 F. (2d) 246

*In re Land*, 109 F. (2d) 251

These cases are primarily cases decided by the Court of Customs and Patent Appeals. They hold that if a patentee has made an invention and has obtained a patent therefor, he has received his reward and has exhausted his rights and that he cannot, by merely adding unpatentable subject matter to the invention, obtain an extension of his monopoly. They hold that there must be more than one invention for more than one patent.

These cases are well reasoned ones. If an inventor makes an invention, he is entitled to the 17 year monopoly. If his invention is broad enough to cover several fields or several modifications, he is entitled to the 17 year monopoly in these fields. He is not, however, entitled to obtain broad protection for all fields or modifications of his invention and obtain a patent therefor and then later obtain another patent for the same invention by merely adding unpatentable features to it and thus limiting it to a specific field or modification. If he can do this, he obtains a monopoly longer than the 17 years prescribed by law.

The situation in the present case is a good illustration of the soundness of the rule. The first Hagen patent is broad enough to cover the petitioner's structure. It granted a monopoly from February 23, 1932 to February 23, 1949. The second Hagen patent grants a monopoly covering the same structure from January 29, 1935 to January 29, 1952. The total monopoly is thus nearly 20 years and not merely 17, yet the inventor has contributed only one inventive concept.

The decision of the Court of Appeals is based upon *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 22 F. (2d) 259, which holds that if patent applications are co-pending, the second need not cover a patentable advance over the first.

There is a definite clash of authority here. The Court of Customs and Patent Appeals, which governs proceedings in the Patent Office, has established its rule that there must be a patentable distinction if there are to be two patents. These decisions affect the right of inventors in all parts of the country. If they are wrong, they should be corrected.

We submit that these decisions of the Court of Customs and Patent Appeals state the preferable rule. They prevent extension of monopoly. They keep an inventor from obtaining two patents which are not inventively different and keep him from thus monopolizing a field more than the 17 years provided by law.

It is not too much to require of an inventor that he confine himself to a single patent for a single invention. If he is required to do so, he has his full recompense and the members of the public are protected against extension of monopoly such as that involved here.

In the present case, the same inventive concept forms the basis for both patents. The second patent defines nothing inventive over what is claimed in the first patent. If both patents are held valid the respondent will have a 20 year monopoly instead of a 17 year one for his single inventive concept.

There is no conflict between decisions of Courts of Appeals involving the specific patents involved here, but there is a conflict between the Master and the District Court on one hand and the Court of Appeals on the other hand on a point of law which has not been settled by this Court and which should be settled by it.



**CONCLUSION**

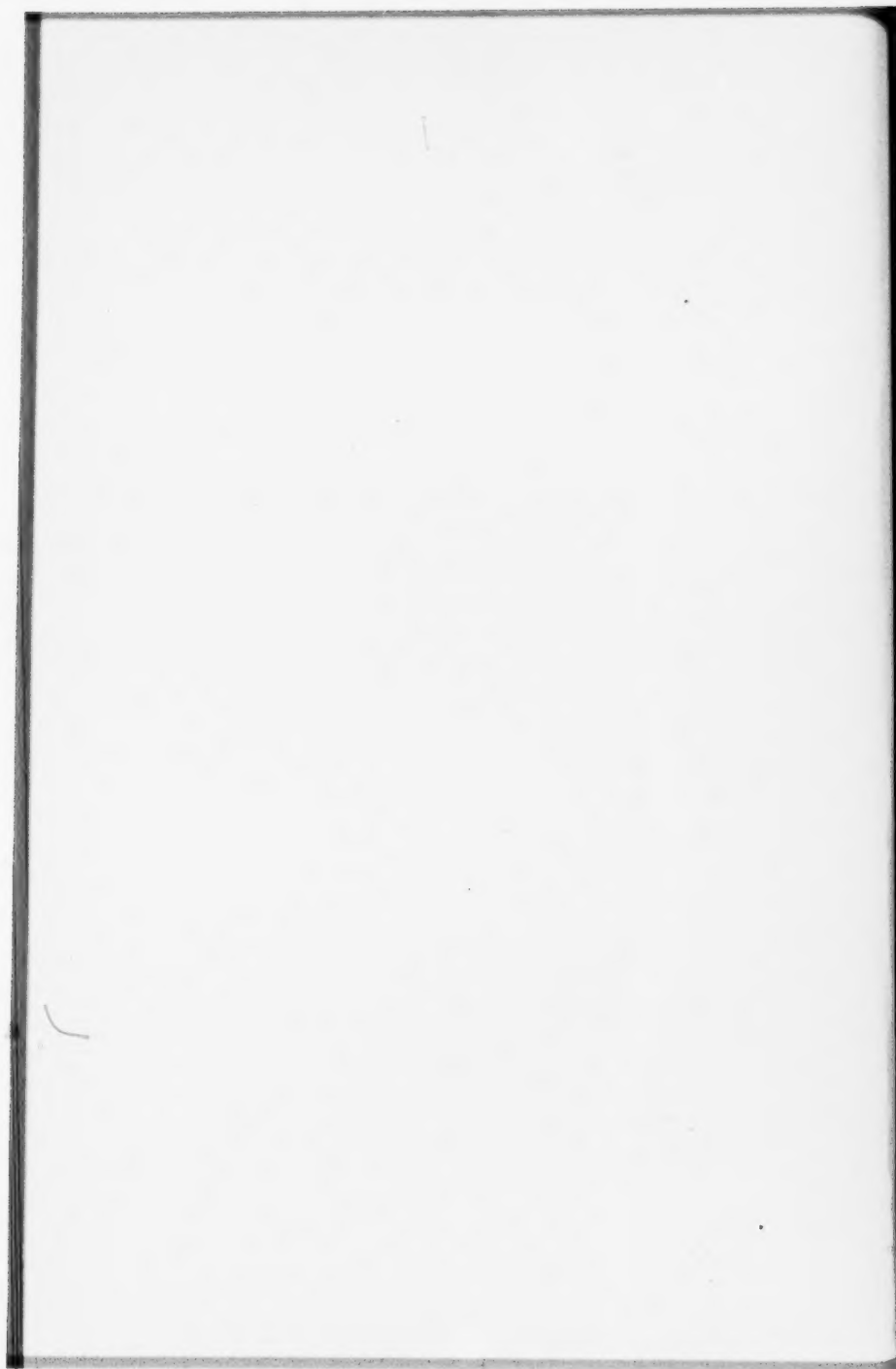
Wherefore, petitioner earnestly prays that the petition for writ of certiorari be granted, the case be reviewed, and the decree of the Court of Appeals for the First Circuit, finding validity for Claim 2 of Hagen patent 1,846,863 and for all claims of Hagen patent 1,989,413 be reversed.

Respectfully submitted,

MASSACHUSETTS HAIR & FELT  
COMPANY

By WILLIAM S. HODGES.

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(18)

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Supreme Court of the United States

OCTOBER TERM, 1941

MASSACHUSETTS RAIL & TRANSIT CO.

U. S. STEAMSHIP COMPANY

RESPONDENT

IN COMPLIANCE WITH ORDER OF COURT

MASSACHUSETTS RAIL & TRANSIT CO.

U. S. STEAMSHIP COMPANY



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In the  
**Supreme Court of the United States.**

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OCTOBER TERM, 1941.

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No. 968.

MASSACHUSETTS HAIR & FELT COMPANY,  
PETITIONER,

v.

B. F. STURTEVANT COMPANY,  
RESPONDENT.

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**RESPONDENT'S BRIEF**

IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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**STATEMENT OF THE CASE.**

At the outset, and as often thereafter as possible throughout its petition and brief in support thereof, petitioner speaks of an "extension of monopoly".

The exclusive rights granted under a patent in a proper case are not rights that are taken away from the public; they are rights that never before existed. They are therefore to be distinguished from monopolies as that term is frequently used to describe the unlawful suppression of free trade and fair competition.

Unfortunately in some instances, attempts have been made to use patents to this same end. This Court has had cases before it in which it appreciated that the owner of a

patent was not content to exercise and enjoy the limited rights conferred by the patent grant but had attempted to extend those rights to unpatented things and thereby unjustly impose an illegal monopoly upon the public. The recent *Morton Salt* case<sup>1</sup> and the *B. B. Chemical* case<sup>2</sup> are examples of such unconscionable practice on the part of patentees. Other inventors, prior to the grant of a patent, seek claims for more than they have a right to claim as their inventions and, if successful in the Patent Office, then attempt to embrace within their apparent patent domain things which are actually free to the public to make, use and vend. Examples of that kind of unlawful monopolistic practice are found in the *Bassick* case<sup>3</sup> and in the *Lincoln* case<sup>4</sup> strongly relied upon by the petitioner here. In all such cases the patentees were infringing upon the rights of the public and the Court was justified in voiding or invalidating their patent rights.

Every inventor is not necessarily seeking "extension of monopoly" just because he has a patent and asks a Court to enjoin an infringer of his limited rights. But if he brings suit for infringement, the defending party will immediately cry "extension of monopoly" and if the patent contains claims for a "combination" the defendant will promptly assert that they are invalid under the rule of the *Bassick* and *Lincoln* cases. Such is the present situation.

There is here no conflict of decisions between Circuit Courts of Appeals. The two patents here in suit have not previously been litigated. Here no question of local law is involved and no question of federal law has been decided which has not been or which should be settled by this Court or which has been decided in a way probably in conflict with

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<sup>1</sup> *Morton Salt Co. v. G. S. Suppiger Co.*, 86 L. Ed. 317.

<sup>2</sup> *B. B. Chemical Co. v. Ellis*, 86 L. Ed. 320.

<sup>3</sup> *Bassick Mfg. Co. v. R. M. Hollingshead Co.*, 298 U.S. 415.

<sup>4</sup> *Lincoln Engr. Co. v. Stewart-Warner Corp.*, 303 U.S. 545.



applicable decisions of this Court. The Circuit Court of Appeals has not so far departed from the accepted and usual practice of judicial proceedings, and has not so far sanctioned such a departure by a lower Court, as to call for an exercise of this Court's power of supervision.

There are here no questions of any dates of invention, of any reissue patent, of any intervening rights, of any licenses to be construed, or of any infringement direct or contributory. There is here no concentration of the industry in any one circuit. The respondent here did not have an early patent soon to expire whose protection it sought to extend by seeking a new patent on minor improvements.

The claims of the two patents here in suit have already been passed upon by the Patent Office, a Special Master, the District Court and the Circuit Court of Appeals. Now this Court is asked to favor the petitioner with still another consideration of these claims. Moreover the specific contentions respecting the application of the rule of the *Bassick* and *Lincoln* cases as well as that of the *Traitel* case<sup>5</sup> have been presented to and fully considered by the judicial tribunals below.

The Clarage Fan Company of Kalamazoo, Michigan, the manufacturer of the infringing apparatus, openly assumed, has conducted and is now conducting the defense of this action (I-175). We include this company as well as the Massachusetts Hair & Felt Company when we use the term petitioner.

### **The Subject-Matter of the Patents.**

Respondent is the owner of two patents, No. 1,846,863 of February 23, 1932 (II-574) and No. 1,989,413 of January 29, 1935 (II-584) granted to it for improvements made by its research engineer, Harold F. Hagen, in respect to a centrifugal fan driven by a constant speed motor and

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<sup>5</sup> *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 22 F. (2d) 259; C.C.A. 2nd.

equipped with adjustable inlet control vanes for varying the spin component of the gases or air entering the fan blades. By changing the position or setting of the control vanes the pressure-volume characteristic of the fan and its output can be varied to meet any change in the demand made on the fan. And the same adjustment of the vanes also produces changes in the horsepower characteristic of the fan which results in a reduction of the power input to the driving motor as the output of the fan is lessened.

The first Hagen patent (No. 1,846,863) discloses what may be termed the generic aspects of Hagen's improvements but only shows how they can be applied to a centrifugal fan of the induced draft type having closed spiral inlet boxes to which gases of combustion are led through a duct system and in which the gases flow between the control vanes to acquire the desired spin before passing through the eye of the fan casing into the spaces between the fan blades. The second Hagen patent (No. 1,989,413) shows the specific application of Hagen's improvement to a centrifugal fan of the forced draft type having an open inlet with control vanes arranged therein to impart the desired spin to the air passing from the atmosphere through the inlet and eye into the spaces between the fan blades.

The only claim of the first patent now in issue\*, claim 2, is sufficiently broad to cover an embodiment of Hagen's improvements with either type of centrifugal fan—induced draft or forced draft. All four claims of the second patent are limited to a specific embodiment of Hagen's improvements with a forced draft fan.

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\*Because claim 1 of the first Hagen patent was held invalid by the Master, the District Court and the Circuit Court of Appeals, a disclaimer of this claim has been filed in the Patent Office.

### **Facts are Unusually Complex and Technical.**

Because of the difficult technical matters involved the case was referred for trial to a Special Master who spent six full days in hearing the parties, much of which time was devoted to expert testimony relating to aerodynamic and hydraulic considerations and to the prior art patents relied upon by the defense. After nearly a year the Master filed his report. It was prepared with meticulous care and fills more than a hundred pages of the printed record (I-34-136). Even a casual examination shows that it is concerned with more fundamental technical questions and far more involved issues of fact than the petitioner's references to the prior art on pages 3 to 5 of the petition would indicate.

The case does not lend itself to such over-simplified treatment. We realize that a petition and its supporting brief must be "direct and concise" but we also know that petitioner's curtailed statements concerning particular vane shapes and mechanical details are not a fair presentation of the multitude of technical issues which have a distinct bearing on this case. To properly present them would require a full discussion of such subjects as variable-speed control, damper control, throttling, pressure-volume, horsepower and system characteristics, Euler's equation, velocity components and vector diagrams, shock-free entry, tangential admission, shock loss, cavitation, work, and fluid flow in a vortex. These very technical matters, relating solely to issues of fact, were all carefully considered by the Master, the District Court and the Circuit Court of Appeals. It is quite obvious that they embrace far more than mere distinctions between flat vanes, curved vanes and streamlined vanes.

## THE ALLEGED ISSUES.

The two "issues" as presented on page 15 of petitioner's brief are no longer issues because the law controlling them has been definitely settled.

The first alleged issue of "whether an inventor, who has improved one element of an old combination, has any valid enforceable right in a patent in which he claims the old combination with the improved element substituted for the old element of the old combination", was squarely presented to this Court in both the *Bassick* case (*supra*) and in the *Lincoln* case (*supra*).

In the *Bassick* case this Court said:

"The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation are otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this can not be done is shown by numerous cases in this and other federal courts." (298 U. S. 425).

And in the *Lincoln* case this Court reaffirmed the rule when it said:

"The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention." (303 U. S. 549).

No clearer or better determination of petitioner's first alleged issue could be made than was made by this Court in the statements quoted above from the *Bassick* and *Lincoln* cases.

The second alleged issue of "whether a patentee who has patented an invention may later obtain a second patent for

the invention of the first patent with unpatentable additions, merely because the application for the second patent was co-pending with the application for the first patent" is an involved statement of assumed facts which boils down to the simple question of whether or not a patentee can have two patents for the same invention. That would be "double patenting" which has been held from the beginning of the patent law to be entirely improper.

If the second patent is for the same invention as the first patent, it is void, and it is immaterial whether the applications for the two patents were copending or not. This is a self-evident truth and requires the citation of no authority to support it. Reference may be made, nevertheless, to *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 198.

If, however, an inventor makes a generic invention capable of embodiment in two or more specific forms, he may get a first patent for the generic invention and a second patent for a specific embodiment not claimed in the first patent, provided the specific embodiment is a separate invention and the claims of the second patent can not be read on the structure shown in the first patent. Under such circumstances the first patent can not be used to invalidate the second patent if their applications were copending in the Patent Office.\* *The Barbed Wire Patent Case*, 143 U.S. 275, 280.

Thus the alleged "issues" presented by the present petitioner have long been determined and well settled matters of law.

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\*This proposition is supported by many cases, a few of which are cited *infra* p. 19.

## SUMMARY OF ARGUMENT.

We shall argue that the petition should be denied because:

The Appellate Court fully considered the rule of law stated by this Court in the *Bassick* and *Lincoln* cases, and, having determined as a matter of fact that while Hagen may have improved the design and arrangement of control vanes he nevertheless made *improved combinations*, properly declined to apply the rule of those cases to the facts here;

The petitioner misinterprets the Appellate Court's decision regarding the second Hagen patent and alleges a conflict of decisions which does not exist.

### ARGUMENT.

#### THE RULE OF THE BASSICK AND LINCOLN CASES DOES NOT APPLY HERE.

The patents in both of these cases had to do with apparatus for lubricating metal bearings, particularly those of automobiles. A tubular fitting is permanently connected with each bearing, and every lubricating station has a grease gun with coupler into which grease is forced under pressure from a pump through a hose, whereby, when the coupler is temporarily connected on the fitting, lubricant will be forced into the bearing.

In the *Bassick* case (298 U.S. 415), claims 14 and 15 of the Gullborg patent 1,307,734 were for the combination of a pin fitting (of a type which had already been claimed separately in another patent of Gullborg No. 1,307,733) with *any* grease gun having a bayonet type coupler (421). The respondents sold grease guns which were "of an old unpatented type", and the petitioners contention was that if the respondents furnished such a gun for use with the patented pin fitting they would contributorily infringe claims 14 and 15 of the patent in suit because these claims describe the combination of any grease gun with the patented pin fitting (424). In other words, the petitioner sought to restrain the respondent from selling to filling stations and garages any type of grease gun, even one that was old and unpatented, on the theory that when such a gun was used with any of the millions of patented pin fittings on automobiles, the alleged combination of claims 14 and 15 would be infringed. Obviously that was an unconscionable use of the patent, and the Court so ruled (425).

The *Lincoln* case (303 U.S. 545) presented an equally flagrant state of facts. "The charge is that the petitioner sells fittings such as are described in the respondent's patent which are usable, and intended to be used, in connection with the gun and coupler of the patent" (546). The

patent referred to is the Butler patent No. 1,593,791. Here the respondent attempted to use a combination patent to restrain the petitioner from selling fittings, although the only new improvement Butler had made was in the coupling member. This Court concluded:

“That Butler’s effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of chuck or coupler to old parts or elements having no new function when operated in connection with the coupler renders the claim void.” (303 U. S. 552).

It might be asserted, we think, that the *Bassick* and *Lincoln* cases apply only to instances in which the patentee endeavors to embrace within his patent more than in equity and good conscience he is entitled to do. Here the respondent is making no such unconscionable attempt and on that score does not deserve the application of the rule of the *Bassick* and *Lincoln* cases. But aside from any question of improper attempt, the rule does not apply here at all.

Let us look at the particular rule stated by this Court in deciding those cases. The rule is fully expressed in the *Bassick* case as follows:

“The question then is whether, by this method, the patentee, by improving one element of an old combination *whose construction and operation are otherwise unchanged*, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element.” (298 U.S. 425).

We have italicized a portion of the above quotation which we believe definitely indicates wherein the present case differs from the *Bassick* case. Similarly, we quote below a statement from the *Lincoln* case, also with a portion italicized to indicate a similar distinction between the *Lincoln* case and the present one.



“The mere aggregation of a number of old parts or elements which, in the aggregation, *perform or produce no new or different function or operation than that theretofore performed or produced by them*, is not patentable invention.” (303 U.S. 549).

The particular point involved here is that Hagen’s claims are not for old combinations whose construction and operation are unchanged by his improvements.

That the Court of Appeals fully appreciated the situation is clear from its final statement after reconsideration of the case. The Court said:

“The reason we do not consider these cases to be in point is that Hagen, unlike the patentees in the *Lincoln* and *Bassick* cases, made no attempt to cover in his patent, which is a combination one, all of the separate parts of the combination including those which were unpatented and old in the art. That is, he did not attempt by his patent to prevent others from using any form of vane controlled centrifugal fan, but attempted only to prevent others from using such a fan, with inlet vanes substantially similar to his. As pointed out in the original opinion the question thus presented is whether or not the new element which he added to the old combination, i. e., the new form and arrangement of the vanes, caused the combination to produce a new and useful result which was not merely the ‘aggregate of several results, each the complete product of one of the combined elements.’ In our original opinion we answered this question in the affirmative with respect to the second patent. The same reasoning applies with at least equal force to the first one and compels a similar answer with respect to it.” (III-828).

Thus the present case is clearly outside the rule of the *Bassick* and *Lincoln* cases.

### HAGEN MADE IMPROVED COMBINATIONS.

The "findings" quoted by petitioner on pages 17 and 18 of its brief,\* when separated from their context in the Master's Report, appear to support the contention that all Hagen improved was the design and arrangement of vanes. Even the petitioner does not question that Hagen did that much. But there are ample findings that Hagen's patentable improvements were something more, namely improved combinations.

The Master reported:

"In the present case, so far as appears, Hagen was the first to develop a constant speed fan wherein the output is controlled by supplying a variable spin to the entering air by means of adjustable vanes at the inlet. His vane controlled fan constitutes a highly useful and valuable contribution to the fan art, has gone into wide use, and has supplied a very real need." (I-106).

"Hagen made the first vane control fan after long experimentation, and it constituted a distinct and valuable contribution to the art. His commercial success was followed by appropriation by the defendant of the essential features of his fan as set forth in claim 2. Hagen is entitled to great credit." (I-112).

"It is true that all Hagen did was to provide adjustment over substantially the entire range, with a design and arrangement of vanes that gave definite, predictable and controlled flow throughout the range, under conditions which reduced throttling or eddy losses to a minimum. True, also, he was applying a known prin-

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\* The quotation on page 19 of petitioner's brief was ordered withdrawn by the Court of Appeals and the text appearing at III-828 was substituted.

ciple. But he took this principle and, by dint of extensive experimentation, for the first time produced a highly successful and useful vane controlled fan, embodying an arrangement, as set forth in claim 2, which was new and which was considered sufficiently important to have been adopted by defendant, following Hagen's development." (I-113-114).

The Circuit Court of Appeals said:

"Hagen's contribution, then, was of a mechanism for controlling the output of a centrifugal fan by vanes, not down to a useless capacity of zero, but only to a minimum capacity. This had practical value and it achieved commercial success. It approximated, if it did not equal, the range of control possible by altering the speed of the impeller, as had been done with efficiency by steam turbines but which could not be efficiently done with the usual type of electric motor available for fan drive after steam turbines had become unavailable for the purpose, and it accomplished this range of control almost entirely by power-saving spin and with a minimum of power-wasting throttling.

"It does not seem to us that it would have occurred to a mechanic or designer skilled in the art either to disregard increasing shock-loss\* by radically increasing the spin of the entering air or to construct vanes of cylindrical contour for the purpose of providing passages between them 'of substantially uniform cross-section as the vanes are moved to closed position', so that control to minimum capacity by spin rather than by throttling would result. Thus the finding of patentable

\*According to testimony of the experts, and as pointed out in the report (I-53, 54) "shock-loss" is the loss of energy at the rotating fan blades as a consequence of the variation in direction of flow effected by the control vanes.

invention made by the master and confirmed and adopted by the court must stand." (III-812).

"At any rate, a finding of invalidity for lack of patentable invention can, under the findings quoted above, be based only on the ground that the mechanism described in this patent is merely an aggregation of old parts, and on that ground the finding cannot be sustained. The reason for this is that the Hagen mechanism for applying vane control to a forced draft fan, although it combined old parts, combined them in such a way as to produce a new and useful result, *i. e.* more predictable and better control over a wide range, such control being almost wholly by spin and almost wholly without throttling, and this new and useful result was the 'product of the combination, and not a mere aggregate of several results, each the complete product of one of the combined elements.' (Authorities). Thus the combination is patentable." (III-815).

The foregoing findings are fully justified by the facts. Among such facts we refer to petitioner's own statements in technical bulletins. Its infringing apparatus is "something entirely new in principle", is "revolutionary, and something which engineers generally have not heard of before", and the results it attains "are little short of startling" (I-68). In one of its bulletins, petitioner stated: "In this connection it should be noted that the Vortex Control operates as a *part of the fan*" (Underscoring theirs, not ours.) (II-609). And in another bulletin petitioner repeats, "Vortex Control operates as a part of the fan" (II-621).

On the back of this same bulletin, the petitioner makes comparative equations between "The Old Way" and "The New Way". Note that in "The New Way" equation petitioner illustrates the *combination* of the fan with the vane or Vortex control and the constant speed motor (II-623).

Hagen's inventions were not directed to any one element but to *improved combinations* of elements which depend upon one another for the joint and cooperative action of the assemblies as a whole. Accordingly the findings of facts made by the Appellate Court were fully warranted and its refusal to apply the rule of the *Bassick* and *Lincoln* cases to the facts here was entirely proper.

On this ground the petitioner has not presented any sufficient reasons for the grant of the petition.

**PETITIONER'S ALLEGATIONS OF CONFLICT OF DECISIONS  
NOT SUPPORTED BY CASES.**

In point 3, page 25, of its brief, petitioner asserts that the "Circuit Court of Appeals for the First Circuit has held that an inventor who has obtained a patent for his invention may obtain a second and later patent, relying upon the same inventive concept, by merely making unpatentable additions to the invention of his first patent, merely because the applications for the patents were copending."

We question if any such construction should be placed upon the Court of Appeals decision.

**The Decision of the Circuit Court of Appeals.**

What the Court said was:

"On the question of anticipation by Hagen's first patent the defendant, citing *Mahn v. Harwood*, 112 U. S. 354; *Toledo Scale Co. v. Computing Scale Co.*, 9 F. (2d) 823; and others of similar import, argues that since the issuance of a patent operates as a dedication to the public of all that might have been claimed therein but was not, Hagen's first patent, in which he failed to claim his apparatus for a forced draft fan, operates to invalidate his second one. The argument is beside the point because Hagen applied for his second patent before his first patent was issued. Both of his applications were co-pending in the patent office from October 31, 1929, to February 23, 1932. Under these circumstances the rule is that when the claims are for separate inventions, as they are here, one being for an induced draft fan and the other being for a forced draft one, 'The issuance of the first patent does not abandon the unclaimed matter in its disclosure, the pendency of the second application rebutting any such inference,' and

this is so even though the claims of the second patent do not 'embody a patentable advance over the earlier disclosure.' *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 22 F. (2d) 259, 260, 261. See also *The Barbed Wire Patent, supra*, 280." (III-815, 816).

As we interpret the foregoing statement, the Court below first points out that, contrary to petitioner's earlier contentions, the fact that Hagen had failed to claim in his first patent the specific embodiment of his improvements in a forced draft fan did not dedicate that embodiment to the public nor abandon it. Such alleged dedication or abandonment was completely contradicted by the fact that before his first patent issued Hagen's application for his second patent was on file in the Patent Office. This is what the court particularly pointed out when it said:

"Under these circumstances the rule is that when the claims are for separate inventions, as they are here, one being for an induced draft fan and the other for a forced draft one, 'The issuance of the first patent does not abandon the unclaimed matter in its disclosure, the pendency of the second application rebutting any such inference', . . .".

The Court of Appeals fully appreciated that in order for the rule to apply, the claims of the two patents must be for *separate inventions*".\* Two patents for the *same* invention cannot be granted, regardless of whether their applications are copending or not. The Court of Appeals was en-

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\* That the claims of the second patent do call for a different combination from that disclosed in the first Hagen patent can readily be determined by attempting to read the claims on the induced draft fan structure. Not a single claim of the second patent can be read on the apparatus shown in the first patent. That fact alone shows that the patents were granted for separate inventions.

tirely clear on that point and stated what has long been regarded as settled law.

### **"Patentable Advance".**

The Court went on to say that the same rule is followed, "even though the claims of the second patent do not 'embody a patentable advance over the earlier disclosure'", citing the *Traitel* case as the source of its quotations. What the Court of Appeals meant in this case, just as did the Court of Appeals for the Second Circuit in the *Traitel* case, is that where an inventor has a generic concept capable of reduction to practice in different embodiments, he may disclose his invention generically or may only show its application to one specific embodiment in one patent, and then disclose and claim another specific embodiment in another patent. Because both specific embodiments, though different, grew out of the original generic concept one embodiment is not deemed to be a patentable advance over the other. Hence the claims of the second patent may not "embody a patentable advance over the earlier disclosure", but if they are for a separate invention, "as they are here", then the first patent cannot be employed to invalidate the second.

### **The Traitel Case.**

That is precisely what was decided in the *Traitel* case. The Court likewise held: that the copendency of the applications of the two patents involved there rebutted any inference of abandonment of the unclaimed matter in the disclosure of the first patent; that "It is familiar law that a species claim may be good invention, notwithstanding that the genus is already in the public demesne, which implies that it is a separate invention,"; and that the "earlier patent was not part of the prior art, and it is not necessary



to the validity of the claims in suit (second patent) that they should embody a patentable advance over the earlier disclosure". But the Court in the *Traitel* case also very pertinently said:

"Therefore all we have to do in the case at bar is to decide whether the claims in suit are for a *separate invention* from the original *claims* allowed upon the first application." [Italics ours.]

### No Conflict of Authority.

Petitioner contends that there is a "definite clash of authority" between the *Traitel* case and some fourteen cases cited on page 26 of its brief. Petitioner treats the *Traitel* case as if it were a single isolated case set against "a large body of authority" contrary thereto. The petitioner is wrong on two points. First, the *Traitel* case is but one of a long line of authorities in this Court and the several Circuit Courts of Appeals. Second, these cases present no conflict with those cited by Petitioner.

The following is a brief list taken from the multitude of cases supporting and following the *Traitel* case:

*Suffolk Mfg. Co. v. Hayden*, 3 Wall. 315, 318.

*Cantrell v. Wallick*, 117 U.S. 689, 694.

*The Barbed Wire Patent Case*, 143 U.S. 275, 280.

*Anderson v. Collins*, 122 F. 451, 458; (C.C.A. 8).

*Century Electric Co. v. Westinghouse*, 191 F. 350, 352; (C.C.A. 8).

*Sandy MacGregor Co. v. Vaco Grip Co.*, 2 F. (2d) 655, 656; (C.C.A. 6).

*Skinner Bros. Belting Co. v. Oil Well Imp. Co.*, 54 F. (2d) 896, 899; (C.C.A. 10).

*City of Milwaukee v. Activated Sludge Inc.*, 69 F. (2d) 577, 587; (C.C.A. 7).

*General Tire & Rubber Co., v. Fisk Rubber Corp.*,  
104 F. (2d) 740, 745; (C.C.A. 6).

The foregoing decisions do not conflict in any way with the fourteen cases cited by petitioner. *Oates v. Camp* has nothing whatever to do with the questions here presented. Twelve of the cases were in the Court of Customs and Patent Appeals on appeals from the Patent Office. One case, *Bissell v. Coc*, is a decision by the Court of Appeals for the District of Columbia under R. S. 4915, equivalent to an appeal from the Patent Office.

A review of the thirteen cases does not support petitioner's contentions regarding conflict of authority. In every case it is quite clear that the second application was not for a *separate* invention from the applicant's first patent. In the footnote below we quote pertinent excerpts from a number of these cases.\*

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\*"We think it clear that the application here in issue does not claim a separate invention from that claimed in the issued patent, but only claims an obvious use of the composition there patented. *In re Byck*, 48 F. (2d) 665, 666.

"The appellant, having disclosed or claimed no matter patentably distinct from that claimed in his existing patent, cannot have a second patent upon the same invention. . . ." *In re Peiler*, 56 F. (2d) 878, 880.

"We agree, however, with the Patent Office tribunals that appellant is here 'claiming nothing more than the same invention in substance as is claimed in the patent,' ". *In re Neuberth*, 82 F. (2d) 718, 720.

"We construe this to be a holding that the compound claimed in appealed claim 56 is, in substance, the same as that of the composition claimed in claim 6 of the patent, and nothing has been presented before us which would lead us to feel justified in holding otherwise." *In re James*, 83 F. (2d) 313, 314.

"For the reasons hereinbefore stated, we think the involved claims embrace only the same invention as is embraced in the claims of appellant's parent application, . . ." *In re Seebach*, 88 F. (2d) 722, 724.

"The facts in that case [*Traitel v. Hungerford*] differ from those in the case at bar." *In re Land*, 109 F. (2d) 246, 250.

". . . In other words, it seems to us that this is another way of

These quotations show clearly that in every one of the cases before the court the applicant was not trying to claim *separate* invention, but was actually trying to get a separate patent for the *same* invention covered by a prior patent. This attempted extension of patent rights was properly condemned by the Court.

But the Court of Customs and Patent Appeals has, when the facts warranted, applied exactly the same rule as that stated in the *Traitel Marble* case. The following is a brief list of cases decided by the Court of Customs and Patent Appeals in which it is clearly stated that the first patent may not be cited against the second patent or application when the second is for a *separate* invention from the first.

*In re Carlton*, 77 F. (2d) 363.

*In re Calvert*, 97 F. (2d) 638.

*In re Davis et al.*, 123 F. (2d) 651.

Furthermore, this rule has been followed by the Board of Appeals of the Patent Office, as indicated by the following representative cases:

*Ex parte Kyrides*, 48 USPQ 337.

*Ex parte McCarthy*, 50 USPQ 480.

*Ex parte Cohen*, 52 USPQ 189.

Conversely, this Court and the Circuit Courts of Appeals have, in infringement suits, invalidated a second patent when it attempted to cover the *same* invention as that claimed in a prior patent of the same patentee, even though the applications were copending in the Patent Office.

*Busell v. Stevens*, 137 U.S. 423.

*Underwood v. Gerber*, 149 U.S. 224.

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ing that appellant would have two patents for the same invention and that, therefore, double patenting would exist." *In re Land*, 77 F. (2d) 251, 252.

*Thomson-Houston Co. v. Jeffrey Mfg. Co.*, 101 F. 121 (C.C.A. 6).

*Lion Fastener, Inc. v. Hookless Fastener Co.*, 72 F. (2d) 985 (C.C.A. 3).

These cases relate to the familiar doctrine of "double patenting". They are identical in import with the cases cited on page 26 of petitioner's brief.

Thus, there is a clear uniformity of decision in the cases of the Circuit Courts of Appeals in infringement cases, and the Court of Customs and Patent Appeals in appeals from the Patent Office.\* All of the courts uniformly hold that whether the applications were copending or not, the inventor may not have two patents for the *same* invention, and all of the courts hold with equal uniformity that in the case of copending applications the inventor is entitled to a second patent if it is for a *separate* invention from the first.

There is no conflict of authority here. The Circuit Court of Appeals in this case found as a *fact* that the two Hagen patents are for *separate* inventions and followed a rule of law which was established by this Court in the *Barbed Wire Patent Case* and has been consistently followed by all Courts ever since.

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\*As a matter of statistics, the greater proportion of cases in the Court of Customs and Patent Appeals refuse the claims of the second application, while the greater proportion of Circuit Courts of Appeals cases hold the second patent valid. The reason is not far to seek. The CCPA takes only those cases which have already been rejected by the Patent Office Examiners and Board of Appeals, but the courts that hear infringement cases work only with patents that have passed through the Patent Office sieve. The fact that there are so few "double patenting" cases in infringement suits shows that the sieve works well. There is no "clash of authority" here.

### **Duration of Patent Terms Not Pertinent Here.**

Petitioner also seeks to make a point of the fact that since Hagen's first patent will expire February 23, 1949, and Hagen's second patent will expire January 29, 1952, Hagen will therefore have exclusive rights under the second patent for three years longer than under the first patent. This is nothing unusual and only means that after the first Hagen patent expires and the public is free to use the invention disclosed, the respondent will continue to have exclusive rights under the second patent to the specific application of the improvements with a forced draft fan.

If it should be felt that a patentee ought not to have the benefit of any protection under a second patent after a first patent has expired, it should be pointed out that this is a matter fixed by law. The patent statutes require each patent to issue for a fixed term of seventeen years. In some countries, notably Great Britain (and also France before the war) provision is made for so-called "Patents of Addition". An inventor there who has a patent for a generic invention and later makes an improvement thereon may get a patent of addition for the improvement. This patent of addition expires on the same date the first patent expires. If such a law were in effect in this country and if Hagen had taken his second patent as a patent of addition, no assertions concerning "extension of monopoly" could be made.

Such is not the law here, however, and Congress has not seen fit to make any provision for patents of addition. Under our statutes a patentee is forced to take his patent for the full term of seventeen years, even though he might be willing, if the law so provided, to accept a second patent for a shorter term. Under these circumstances, petitioner's argument on this point should be directed to Congress and not to the courts.

CONCLUSION.

“A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor.” (Rule 38 of this Court.)

The petition sets forth no special and important reasons justifying its grant and we therefore pray that it be denied.

Respectfully submitted,

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MAY 27 1941

CHARLES SUMNER JOHNSON  
CLERK

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1941

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No. 968  
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**MASSACHUSETTS HAIR & FELT COMPANY,**

Petitioner,

vs.

**B. F. STURTEVANT COMPANY,**

Respondent  
---

**REPLY BRIEF OF PETITIONER**  
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## AUTHORITIES

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Respondent  
— — —

**REPLY BRIEF OF PETITIONER**  
— — —

There are special and important reasons which justify the granting of review on writ of certiorari in this case.

In this case as in the *Bassick* and *Lincoln* cases,\* the patentee improved one element of an old combination and in his patent claimed the old combination with the improved element incorporated therein. This case differs from the *Bassick* and *Lincoln* cases, however, in that the defendant here is using a structure which embodies all of the elements of the claims and is not merely selling old

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\**Bassick Mfg. Co. v. R. M. Hollingshead Co.*, 298 U. S. 415,  
*Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545.

elements knowing and intending that they be used with the other elements of the claims.

The Court of Appeals was of the opinion that this difference is of controlling importance because it said (R. V. III, p. 828):

“The reason we do not consider these cases to be in point is that Hagen, unlike the patentees in the *Lincoln* and *Bassick* cases, made no attempt to cover in his patent, which is a combination one, all of the separate parts of the combination including those which were unpatented and old in the art. That is, he did not attempt by his patent to prevent others from using any form of vane controlled centrifugal fan, but attempted only to prevent others from using such a fan, with inlet vanes substantially similar to his.”

In so ruling, the Court of Appeals has either rendered a decision in conflict with the decisions of this Court in the *Bassick* and the *Lincoln* cases, or else it has decided a question of federal law which has not been and which should be settled by this Court and has decided it in a way probably in conflict with the applicable decisions of this Court and certiorari should be granted.

We have assumed from the date of the *Bassick* and *Lincoln* decisions that they were applicable to all cases involving patents in which the patentee claimed an old combination, even though his contribution was merely an improvement in one element thereof, and we have assumed that the decision of the Court of Appeals is in direct conflict with these cases which would warrant the issuance of the writ of certiorari. The Court of Appeals has, however, found something in the *Lincoln* and *Bassick* decisions which has led the Court of Appeals to its conclusion that

the *Bassick* and *Lincoln* cases apply only when a patentee seeks to control commerce in unpatented articles which are elements only of the claims and which do not in and of themselves fall within the claims. The respondent likewise finds something in the *Bassick* and *Lincoln* cases to limit them only to instances in which the patentee endeavors to embrace within his patent more than in equity and good conscience he is entitled to do (see Respondent's Brief p. 10).

The fact that the Judges of the Court of Appeals and respondent's counsel find such a limitation in the *Bassick* and *Lincoln* cases makes it clear that there is need for clarification. If the rule is not clarified, the decision of the Court of Appeals in this case will be good authority for the imposition of a greatly narrowing and restricting rule on the *Bassick* and *Lincoln* cases.

We believe that there was no intent in the *Bassick* and *Lincoln* cases to limit the rule as the Court of Appeals has done in this case. We believe that this Court intended to proscribe any extension of monopoly such as a patentee obtains when he claims an old combination with a new element therein. We believe that if the plaintiffs in the *Bassick* and *Lincoln* cases had brought action against the ultimate users of the patented combination, the result would have been the same. This Court would not countenance an extension of monopoly in an old combination to one who has merely improved one element.

### **There Is An Attempt to Extend Monopoly Here**

On page 3 of its brief, the respondent states that it does not have a patent which is to expire soon whose protection it seeks to extend with a patent on minor improvements. The respondent overlooks the fact that it was, when suit was filed, operating under an exclusive license under Moody patent 1,460,428 (R. V. II, p. 678) (now expired), and Moody patent 1,578,843 (R. V. II, p. 692) (which expires March 30, 1943). These two Moody patents give the respondent broad protection on the combination and the invention of the patents in suit lies merely in improving the vanes and not the combination.

### **The Hagen Invention Lay Merely in Improving the Vanes**

It is impossible to escape the conclusion that Hagen's only contribution lay in his design of the vanes. The Court of Appeals made this clear in its original opinion where it stated that Hagen's contribution was a mechanism for controlling the output of a centrifugal fan by means of vanes (R. V. III, p. 812). This was emphasized in the opinion rendered after the first rehearing (R. V. III, p. 824). It is fully backed up by the Master's specific findings referred to on pages 17-18 of Petitioner's Brief filed with the Petition for Writ of Certiorari.

The respondent contends on pages 12-15 of its brief that Hagen's invention was a combination, but it is clear even from the quotations there made that Hagen's invention was directed to improving the vanes only.

It is suggested on pages 10-11 of respondent's brief that Hagen's improved vanes made a new combination because they worked better than the old vanes used by Eickhoff



(R. V. II, p. 670), Moody (R. V. II, 678), Beaudrey (R. V. II, p. 765), and Brown-Boveri (R. V. II, p. 747). The fact that the vanes were improved would, of course, give improved results, but these improvements are none the less merely improvements in vanes. They do not change the operation of the motor, or the operation of the fan. The motor merely drives the fan and the fan merely moves the air.

The Master, the District Court and the Court of Appeals all agree that Hagen's contribution was merely an improvement in vanes. The subsidiary findings all point to this. The only suggestion that this is not the case lies in the very general and confused statement made by the Court of Appeals in its final modification of its opinion on rehearing (R. V. III, p. 828).

The formation of and mounting of the vanes for a wider range of movement was an improvement in vanes. The curving of the vanes to make them approach parallelism and form passages of substantially uniform cross section was an improvement in vanes. The formation of the vanes to eliminate throttling was an improvement in vanes. These improvements were what led to the more predictable results. The Hagen vanes performed the function of the prior art vanes but did it more efficiently. They did not change the construction or operation of the fan or motor in any way.

**The Decision of the Court of Appeals Does Conflict  
With a Large Body of Cases**

The first Hagen patent was broad enough to cover either the specific form of vanes shown in the patent (R. V. II, p. 574) or the form of vanes shown in the second Hagen patent (R. V. II, p. 586) provided the vanes were adjustable from open to closed position to give the full range of spin control. Hagen thus had a monopoly in both types of vanes. This monopoly granted under his first patent expires February 23, 1949.

In the second patent Hagen has an overlapping monopoly. It covers the form of vanes shown in the second patent and also covered in the first one. This monopoly does not expire until January 29, 1952.

Hagen obtained his second monopoly by merely adding as elements unpatentable mechanical details which had already become well known in the art through Moody and others. He merely combined with the subject matter of his first patent these unpatentable details so that the claims of the second patent would have additional elements in them.

The Master and District Court both saw that the same inventive concept had to support both patents and they ruled that the second patent was invalid because of the first patent and the prior art which showed the unpatentable details.

The Court of Appeals took the view, however, that since the applications for these patents were co-pending, it was immaterial whether there was any patentable distinction between the first and the second patent.

This is in direct conflict with the decisions cited by petitioner on page 26 of its brief in support of the Petition

for Writ of Certiorari. In practically every one of these cases, the inventor had obtained a patent for an invention. He had then applied for another patent in which he relied upon the inventive concept of his first patent and merely added non-inventive elements. In every instance, he was denied a second patent on the theory that one invention will support only one patent.

The respondent contends in its brief that there is no conflict between the decision of the Court of Appeals in this case and the cases cited by petitioner. The respondent contends that in the cited cases the applicant for patent was trying to get another patent for the identical invention. That is not the case. In every one of the cases cited, the applicant for patent had added some element to the invention of his prior patent. The added element was either mechanical or chemical or related to use, but in every instance the terminology of the claims differed materially. In every instance, however, the same inventive concept had to be relied upon to establish patentability.

In the present case, Hagen had the concept of making vanes of a certain form to give certain results and the concept of adjusting them from maximum to minimum. He obtained a patent therefor and then in his second patent, he merely modified the claims to this same invention by adding unpatentable mechanical details which are disclosed in the Moody patents. These details were old and well known and the man skilled in the art would have applied the first Hagen invention to the type of vane shown in the second Hagen patent without exercising any invention. The second patent, however, forecloses him from doing this. Even after the expiration of the first Hagen patent, he will not be able to use its principles in all of the well known vane forms and mountings because the second patent has set aside this territory as a monopoly for an additional period of time.

Both the Master and the District Court saw that the effect of the second Hagen patent was to extend the monopoly of the first patent in a field which was well known and adequately covered in the first patent. They saw that to sustain the second patent would be to extend the monopoly without calling upon Hagen for any further inventive acts than he had performed to obtain his first patent.

### Conclusion

It is submitted that the petition sets forth special and important reasons justifying this Court in granting a review on writ of certiorari. The Court of Appeals has either rendered a decision contrary to the decisions of this Court in the *Bassick* and *Lincoln* cases or has decided a question of Federal Law which should be decided by this Court and which has not been so decided and has decided it contrary to controlling authority. The Court of Appeals has also decided a question raised under the second Hagen patent in a manner in conflict with a large body of important decisions and, we submit, contrary to the basic principles of patent law. This Court should resolve the conflict.

It is respectfully urged that the petition be allowed.

Respectfully,

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